

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

15142US02

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on _____

Signature _____

Typed or printed name _____

Application Number

10765813

Filed

01/27/2004

First Named Inventor

Lakshamanan Ramakrishnan

Art Unit

2483

Examiner

David N. Werner

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Mirut P. Dala/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Mirut P. Dala

Typed or printed name

☒ attorney or agent of record.
Registration number 44,052

312-775-8000

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

August 12, 2011

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

Claims 9-12 and 20-21 are presently pending, and claim 23 is added. Claims 1-4 and 13-15 are withdrawn from consideration. Claims 5-8, 16-19, and 22 are cancelled without prejudice. Pre-appeal review is respectfully requested.

Claims 9, 20, and 23 were rejected under 35 U.S.C. 103(a) as being obvious from the combination of Piazza in view of Vartti, and further in view of Lee.

In the Previous Response, Assignee Argued:

Piazza indicates that "The compressed macroblock is then loaded into cache memory 810 (paragraph 0066). Cache memory 810 is the claimed 'local buffer'." Office Action at 3. However, Piazza does not teach that "compressed video data stored in the local buffer, wherein the portion comprises a macroblock row". However, the Office Action indicates that Lee discloses "a macroblock row", and that it would be obvious to combine Piazza, and Vartti, with Lee.

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie*

conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. MPEP 2142.

Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). *C.f.*, *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (error not to consider factual evidence submitted to counter a **35 U.S.C. 112** rejection); *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention and opining that the art teaches away from the invention.); *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 ("[Rebuttal evidence] may relate to any of the *Graham* factors including the so-called secondary considerations."). MPEP 2145.

Assignee respectfully submits that the use of "macroblock rows" provides unexpected results. In the present case, the combination of Piazza and Vartti differ from the present invention in that Piazza and Vartti do not teach "macroblock rows", but only a macroblock.

MPEG-2 uses variable length coding. In variable length coding, later symbols are data-dependent on earlier

symbols. Accordingly, the later symbols cannot be decoded without the earlier symbols. To allow encoding starting at various intervals, MPEG-2 uses what are known as slices. Slices can include several macroblocks. A variable length decoder cannot start with decoding a given macroblock that occurs in the middle of a slice.

However, according to the MPEG-2 standard, the first macroblock of a row is guaranteed to be the first macroblock of a slice. Therefore, by using macroblock rows, the variable length decoder can always start decoding the macroblock row, and consequently, each macroblock in the row. Thus, use of macroblock rows provides an unexpected results over just macroblocks. The unexpected results are evidence of the non-obviousness of adding "macroblock rows" to Piazza and Vartti, notwithstanding the teachings of Lee.

In Response Examiner Relies on Ex Parte Obiaya:

Contrary to Examiner's assertion, the facts of the present case are not even remotely similar to Ex Parte Obiaya. In Obiaya, "Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art" and a result "flowing naturally from following the suggestion of the prior art cannot be the basis for patentability *when the differences would be otherwise obvious.*" Emphasis Added. Additionally, in Obiaya, the Board found that the combination of references merely produced additive benefits.

However, in the present case, Assignee has clearly shown above that the results and unexpected advantages

would not flow naturally from following the suggestion of the prior art.

Examiner argues that "Lee discloses the claimed use of macroblock rows (slices) and that it discloses a benefit of reduction in a processing bottleneck during entropy decoding as a result of the use of macroblock rows." However, the advantage that "the first macroblock of a row is guaranteed to be the first macroblock of a slice. Therefore, by using macroblock rows, the variable length decoder can always start decoding the macroblock row, and consequently, each macroblock in the row" does not flow naturally from the alleged advantage shown in Lee.

Conclusion

For at least the foregoing reasons, each of the pending claims is in a condition for allowance. Examiner is requested to pass this case to issuance.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,



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